

## **REMARKS**

This is a full and timely response to the outstanding non-final Office Action mailed March 28, 2006. Upon entry of the amendments in this response, claims 1 - 10 remain pending. In particular, Applicant has amended claims 1, 2 and 7. Reconsideration and allowance of the application and presently pending claims are respectfully requested.

### **Double-Patenting Rejection**

The Office Action indicates that claims 1 - 10 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 4 of U.S. Application Number 11/037,994.

In this regard, Applicant acknowledges the rejection. However, due to the provisional nature of the rejection, no further action is warranted at this time.

### **In the Specification**

The Office Action indicates that the Specification is objected to because the Abstract is too short. Correction has been made to comply with the Office Action's request. Support can be found in the disclosure in page 4, lines 10-21 of the present application. No new matter has been added. A clean copy of the Abstract also is submitted herewith.

### **In the Drawings**

The Office Action indicates that the new corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because of reasons listed on form PTO-948. In response, Applicant submits herewith a proposed drawing correction. Additionally, Applicant submits herewith seven replacement sheets of drawings. No new matter has been added. Reconsideration of the objection of the drawings is hereby requested. If the proposed

drawing correction overcomes the pending objection, Applicant respectfully requests that the replacement sheets of drawings be entered in the application.

### **Rejections Under 35 U.S.C. §102**

The Office Action indicates that claims 1 – 5 and 7 - 10 stand rejected under 35 U.S.C. §102(e) as being anticipated by *Zdeblick*. Specifically, the Office Action asserts that *Zdeblick* discloses “a fusion system having fusing means comprising a trochar, a retractor having retractor means and a drill having decorticating means. The drill has a head at the base having a planar and extends from said head to be able to engage a facet joint. Disclosed is a sizing means for determining the appropriate implant. (Paragraph 59 and 60).”

Before advancing on the merits, Applicant needs to point out the specificity problem in the Office Action. Except briefly mentioning “Paragraph 59 and 60,” the Office does not specifically point out which portions in *Zdeblick* the anticipation is asserted and based upon. In this regard, Applicant cannot reasonably be expected to guess the basis upon which the anticipation is made. Besides, Applicant cannot locate “Paragraph 59 and 60” through out the entire *Zdeblick* patent. It is therefore requested that the Office point out specific portions it uses for the anticipation rejection. Applicant, however, proceeds on the merits in the following as far as the Office’s reasoning can be perceived.

Applicant respectfully traverses the rejections by amending claims 1, 2 and 7. The amendments are supported by FIG. 3 and the disclosure in page 4, lines 10-21 of the present application. No new matter has been added.

In this regard, Applicant has amended claim 1 to recite:

1. A facet fusion system for fusing a facet joint comprising:  
  
a trochar arranged and configured for use during percutaneous  
  
retraction;

a retractor arranged and configured for use during percutaneous retraction; and

a facet bur arranged and configured for decorticating the facet joint, said facet bur comprising *a shaft being adapted releasably to engage a power source for rotation*;

wherein said trochar, said retractor, and said facet bur are implemented to prepare the facet joint for fusion.

(Emphasis added).

As clearly made in claim 1 and well explained in page 4, lines 10-21 of the present application, the facet bur comprises a shaft that is adapted *releasably* to engage a power source for rotation, such as a surgical drill, or the like. Preferably, the facet bur also comprises a head to decorticate the facet joint upon being engaged with the shaft while rotating at a desired speed, thereby tapering the facet joint into a desired configuration. Because the shaft is releasably engaged with the power source, the facet bur can be released and replaced accordingly. Consequently, a set of different facet burs can be designed for different purposes when the facet joint is decorticated. For example, the head of the facet bur can be designed in various shapes to taper the facet joint into its duly desired configuration.

In contrast, *Zdeblick* does not disclose such releasable feature and thus cannot enjoy the benefits accordingly. As perceived by Applicant, the Office seems to compare *Zdeblick's* drill with the facet bur in claim 1. Applicant responds along the same vein. In this regard, *Zdeblick* generally discloses a “laparoscopic surgical technique” (*Zdeblick* at Abstract, line 1). In particular, *Zdeblick* discloses:

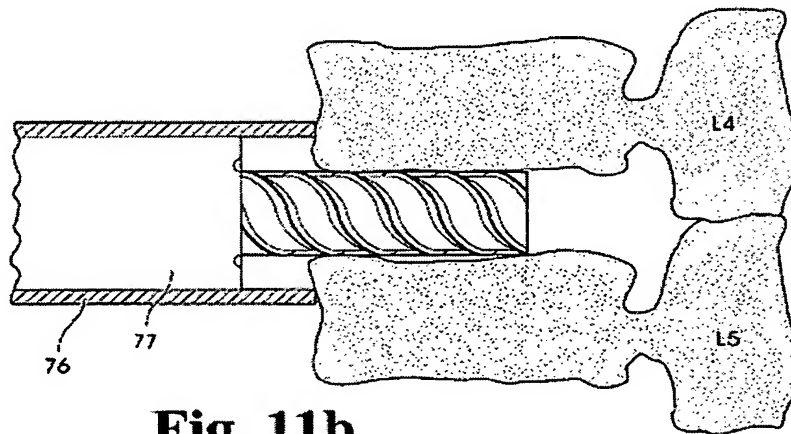
\* \* \* The outer sleeve 76 can be configured to positively engage the anterior aspect of the vertebral bodies to firmly, but temporarily, anchor the outer sleeve 76 in position. In essence, this outer sleeve 76 operates as a working channel for this approach. In the step of FIG. 11(b), a *drill 77* of

known design is *extended through the outer sleeve* and used to drill out circular openings in the adjacent vertebral bodies. \* \* \*

(Zdeblick in col. 11, lines 15-19). (Emphasis added).

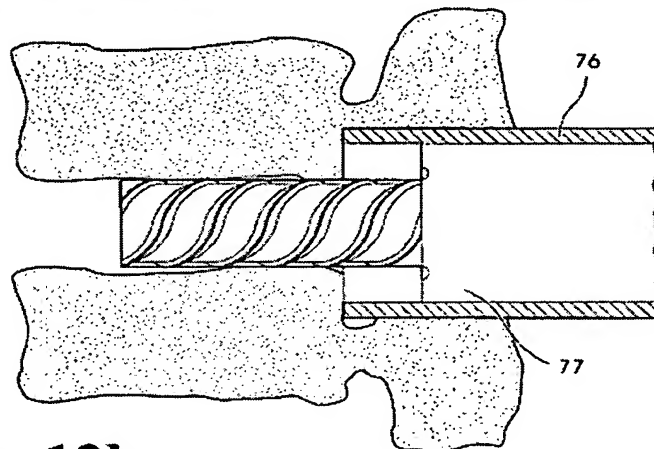
Based on the teachings of Zdeblick above, it can be seen that Zdeblick's drill 77 is *extended through the outer sleeve 76 without* being adapted releasably to engage a power source for rotation. This is in direct contrast to the limitations recited in Applicant's amended claim 1. Furthermore, this is also confirmed by the related Fig. 11b and Fig. 12b of Zdeblick.

**2. Place outer sleeve & drill minor diameter hole:**



**Fig. 11b**

**2. Place outer sleeve & drill minor diameter hole:**



**Fig. 12b**

Applicant respectfully asserts that *Zdeblick* is legally deficient for the purpose of anticipating claim 1. In particular, Applicant respectfully asserts that *Zdeblick* does not teach or otherwise disclose at least the features/limitations emphasized above in claim 1. That is, *Zdeblick* does not disclose in any respect a “facet bur comprising a shaft being adapted releasably to engage a power source for rotation,” as recited in claim 1.

Therefore, Applicant respectfully asserts that claim 1 is substantially different from *Zdeblick* and is in condition for allowance. Since claims 2-5 are dependent claims that incorporate all the features/limitations of claim 1, Applicant respectfully asserts that claims 2-5 are also in condition for allowance. Additionally, claims 2-5 recite other features/limitations that can serve as an independent basis for patentability.

Claim 7 is also amended by adding the same features/limitations in claim 1. It is therefore believed that claim 7 is also substantially different from *Zdeblick* and is in condition for allowance. Since claims 8-10 are dependent claims that incorporate all the features/limitations of claim 7, Applicant respectfully asserts that claims 8-10 are also in condition for allowance. Additionally, claims 8-10 recite other features/limitations that can serve as an independent basis for patentability.

Reconsideration of the rejections of claims 1-5 and 7-10 is hereby requested.

### **Rejections Under 35 U.S.C. §103**

The Office Action indicates that claim 6 stands rejected under 35 U.S.C. 103(a) as being unpatentable over *Zdeblick* in view of *Goble*.

Since claim 6 is a dependent claim that incorporates all the features/limitations of claim 1, Applicant respectfully asserts that claim 6 also is in condition for allowance. Additionally, claim 6 recites other features/limitations that can serve as an independent basis for patentability. Reconsideration of the rejection of claim 6 is hereby requested.

## CONCLUSION

Favorable consideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,



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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on 6/28/06.

Stephanie Riley  
Signature